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| EXAMINER | |
|---|---|
| LEE, JINHEE J | |

| ART UNIT | PAPER NUMBER |
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| 2175 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/594,915 | SHIMIZU, HAJIME | |
| | Examiner | Art Unit | |
| | Jinhee J. Lee | 2175 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *0906*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 9/29/06 has foreign documents which fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because full translation is required to fully consider the prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The device claims disclose having “a screen” which is physical tangible device in use for the invention; therefore, 101 requirements are met.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 10-12, 14-16, 19 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiroshi (JP4172496, English abstract and figures only).

Re claim 1, Hiroshi discloses an electronic device that displays moving picture icons, comprising: a screen, on which, while an icon is being selected, the icon continues to move (when cursor in region…dynamic display, see purpose for example).

Re claim 2, Hiroshi discloses an electronic device that displays moving picture icons, which displays an icon on a screen, comprising:

a section for detecting a selection of an icon, which detects that the icon on said screen has been selected (see purpose where "detection region…cursor is judged to be in an icon region" for example);

a section for acquiring moving picture icon image information, which acquires icon image information that is related to the icon regarding which selection has been detected by said section for selecting and detecting an icon, and which continues to move while the process of said detection continues (dynamic display of icon as an animation for example); and

a section for displaying a moving picture icon image for displaying the moving icon image information acquired through the section for acquiring moving picture icon image information (dynamic display of icon as an animation for example).

Re claim 3, Hiroshi discloses an electronic device further comprising: a section for storing moving picture icon image information that relates to said moving picture icon image information to the relevant icon identification information and stores the resulting information (see constitution, animation display stored are displayed for example).

Re claim 4, Hiroshi discloses an electronic device, wherein a plurality of items of the moving picture icon image information is related to a single piece of icon identification information (anicon, animated icon with frame by frame showing, see purpose and constitution for example).

Re claim 5, Hiroshi discloses an electronic device, wherein said section for acquiring moving picture icon image information comprises, means for acquiring information (such as image detail for example) concerning a still image portion that acquires information concerning the still image portion forming a still image in said moving icon that continues to move, and means for acquiring information concerning the moving picture portion that acquires information concerning the moving picture portion that solely forms the moving picture in said moving icon that continues to move (see purpose and constitution of the abstract for example) .

Re claim 6, Hiroshi discloses an electronic device, wherein the information concerning the moving picture portion acquired by said means for acquiring information concerning a moving picture portion commonly relates to a plurality of icons (see figure 4 for example).

Re claim 7, Hiroshi discloses an electronic device, further comprising: a section for acquiring suspension information that acquires suspension information for

suspending the aforementioned movement, even while said detection of said moving picture icon image information continues, wherein said section for consecutively displaying moving picture icon images suspends said movements when said section for acquiring suspension information obtains said suspension information (see constitution section “cursor has left the icon region…returned to a static image" for example) .

Re claim 10, Hiroshi discloses an electronic device according to any one of claims 1 to 4. Hiroshi does not explicitly disclose in the English abstract wherein said electronic device is a cellular phone. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 11, Hiroshi discloses a method of displaying a moving picture icon, which is a method for operation of an electronic device for displaying an icon on a screen, comprising:

Selecting and detecting an icon so as to detect that the icon on the screen has been selected (icon region detection means for example);

acquiring moving picture icon image information, whereby the information is acquired and the information corresponds to an icon regarding which the selection thereof is detected by said step for selecting and detecting the icon, during which information continues to move while said detection continues (icon as an animation, frame by frame by means of high speed switching and showing for example); and

displaying moving picture icon image information that displays moving picture icon image information acquired by said step for acquiring moving picture icon image information (showing and display switching means for a dynamic display for example).

Re claim 12, Hiroshi discloses a mobile terminal device displaying an icon on a screen, comprising:

a section for storing icon image information that stores image information regarding the icon that should be displayed on said screen (image of animation display stored for example);

a section for selecting and detecting an icon so as to detect that the icon on the screen has been selected (detection means, icon region for example);

a section for generating information concerning a group of icon images displayed at the time of selection that acquires icon image information that corresponds to an icon regarding which selection is detected by said section for selecting and detecting an icon from said section for storing icon image information, processes the icon image information, and generates information concerning the group of icon images displayed at the time of selection that includes a plurality of different new items of icon image information (animation display stored are displayed, frame by frame means, dynamic display for example); and

a section for consecutively displaying icon images displayed at the time of selection that displays an icon image based on new icon image information included in information concerning a group of icon images displayed at the time of selection that is generated by said section for generating information concerning the group of icon

images displayed at the time of selection (dynamic display of the icon as an animation for example).

Re claim 14, Hiroshi discloses, wherein said section for generating information concerning the group of icon images displayed at the time of selection comprises, a means for partial processing that performs partial processing in regards to an icon regarding which selection has been detected by the section for selecting and detecting an icon (information is transmitted to display for example).

Re claim 15, Hiroshi discloses, further comprising: a section for generating information concerning the group of icon images displayed at the time of selection that acquires and processes icon image information that does not correspond to an icon regarding which selection has been detected by said section for selecting and detecting from said section for storing icon image information, wherein the section for generating information generates information concerning the group of icon images displayed at the time of selection that comprises a plurality of different new items of icon image information (frame by frame and figure 4 for example) .

Re claim 16, Hiroshi discloses, further comprising: a section for displaying background image information that displays the background image information in the form of an image that structures the background on said screen not displaying an icon, and a section for changing the display of background image information that changes the display of said section for displaying background image information if said section for selecting and detecting detects selection (changing background image, see figure 5 for example).

Re claim 19, Hiroshi discloses, comprising: a section for acquiring icon image information, wherein the icon image information acquired through said section for acquiring icon image information is stored in said section for storing icon image information (image stored, image is information for example).

Re claim 24, Hiroshi discloses a method of operating a mobile terminal device that comprises a section for storing icon image information that stores icon image information that should be displayed on the screen, comprising:

selecting and detecting an icon so as to detect that an icon on the screen has been selected (icon region by a detection means for example);

generating information concerning a group of icon images displayed at the time of selection involving acquisition and processing of icon image information that corresponds to the icon whose selection is detected through the section for selecting and detecting an icon from the section for storing icon image information and information concerning a group of icon images displayed at the time of selection comprises a plurality of different new items of icon image information is generated (see figure 4 and abstract for example); and

consecutively displaying icon image displayed at the time of selection whereby consecutive outputting takes place regarding a new icon image included among information concerning a group of icon images displayed at the time of selection that is generated through the step for generating information concerning the group of icon images displayed at the time of selection (see abstract for example). It has been held

that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 8, 9, 13, 17, 18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi.

Re claim 8, Hiroshi substantially discloses an electronic device as set forth in claim 7 above. Hiroshi does not explicitly disclose wherein said suspension information is obtained upon entering a power-saving mode. It would have been an obvious matter of design choice to have it programmed to have wherein said suspension information is obtained upon entering a power-saving mode, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of

those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 9, Hiroshi substantially discloses an electronic device as set forth in claims 2-4 above. Hiroshi does not explicitly disclose wherein circulating-form moving picture icon image information concerns the movements of moving pictures based on the moving picture icon image information that moves for a prescribed time applies. It would have been an obvious matter of design choice to have it programmed to have wherein circulating-form moving picture icon image information concerns the movements of moving pictures based on the moving picture icon image information that moves for a prescribed time applies, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the

combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 13, Hiroshi substantially discloses an electronic device as set forth in claim 12 above. Hiroshi does not explicitly disclose wherein said generation by said section for generating information concerning the group of icon images displayed at the time of selection is sequentially performed for each instance of display by said section for consecutively displaying icon images displayed at the time of selection, and said generated information is deleted after the end of displaying thereof. It would have been an obvious matter of design choice to have it programmed to have wherein said generation by said section for generating information concerning the group of icon images displayed at the time of selection is sequentially performed for each instance of display by said section for consecutively displaying icon images displayed at the time of selection, and said generated information is deleted after the end of displaying thereof, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements,

and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 17, Hiroshi substantially discloses an electronic device as set forth in claims 12 or 13 above. Hiroshi does not explicitly disclose wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for changing icon color information that changes a whole or a part of the icon color information, which is information relating to the color of an icon, among the icon image information corresponding to said icon regarding which selection has been detected. It would have been an obvious matter of design choice to have it programmed to have wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for changing icon color information that changes a whole or a part of the icon color information, which is information relating to the color of an icon, among the icon image information corresponding to said icon regarding which selection has been detected, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83

USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 18, Hiroshi substantially discloses an electronic device as set forth in claims 12 or 13 above. Hiroshi does not explicitly disclose wherein said section for generating information concerning the group of icon images displayed at the time of selection comprises, means for changing the icon luminance information that changes a whole or a part of the icon luminance information, which is information relating to icon luminance, among the icon image information that corresponds to the icon regarding which selection has been detected. It would have been an obvious matter of design choice to have it programmed to have wherein said section for generating information concerning the group of icon images displayed at the time of selection comprises, means for changing the icon luminance information that changes a whole or a part of the icon luminance information, which is information relating to icon luminance, among the icon image information that corresponds to the icon regarding which selection has been detected, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed

improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 20, Hiroshi substantially discloses an electronic device as set forth in claim s 2-4 above. Hiroshi does not explicitly disclose wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for extracting an item within an icon image that extracts a portion exhibiting a high degree of luminance in an icon image regarding which selection has been detected via the section for selecting and detecting an icon, and means for displaying a kirakira-mark, which displays a kirakira-mark in regards to the item within the icon image extracted by said means for extracting the item from within the icon image. It would have been an obvious matter of design choice to have it programmed to have wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for extracting

an item within an icon image that extracts a portion exhibiting a high degree of luminance in an icon image regarding which selection has been detected via the section for selecting and detecting an icon, and means for displaying a kirakira-mark, which displays a kirakira-mark in regards to the item within the icon image extracted by said means for extracting the item from within the icon image, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 21, Hiroshi substantially discloses an electronic device as set forth in claims 20 above. Hiroshi does not explicitly disclose wherein an indicator that operates in connection with transfer of kirakira that performs processes whereby a kirakira-mark displayed by said means for displaying a kirakira-mark is transferred from the icon

regarding which selection has been detected most recently by the section for selecting and detecting an icon to the icon regarding which selection is currently being performed through the section for selecting and detecting an icon, following which such kirakira-mark is displayed. It would have been an obvious matter of design choice to have it programmed to have an indicator that operates in connection with transfer of kirakira that performs processes whereby a kirakira-mark displayed by said means for displaying a kirakira-mark is transferred from the icon regarding which selection has been detected most recently by the section for selecting and detecting an icon to the icon regarding which selection is currently being performed through the section for selecting and detecting an icon, following which such kirakira-mark is displayed, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as

obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 22, Hiroshi substantially discloses an electronic device as set forth in claims 12 or 13 above. Hiroshi does not explicitly disclose wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for forming a circular ripple pattern that forms a circular ripple pattern in the icon image regarding which selection has been detected by said section for selecting and detecting an icon. It would have been an obvious matter of design choice to have it programmed to have wherein said section for generating information concerning a group of icon images displayed at the time of selection comprises, means for forming a circular ripple pattern that forms a circular ripple pattern in the icon image regarding which selection has been detected by said section for selecting and detecting an icon, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the

combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 23, Hiroshi substantially discloses an electronic device as set forth in claims 12 or 13 above. Hiroshi does not explicitly disclose wherein said mobile terminal device has telephone functions. It would have been an obvious matter of design choice to have it programmed to have wherein said mobile terminal device has telephone functions, since such a modification would have involved the mere application of a known technique to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

## *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M- F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/
Primary Examiner, Art Unit 2175

jjl